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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,520

Applicant(s)

ODOM, WAYNE

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-12, 14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuchs (US Patent No. 5,630,753) in view of Richardson (US Patent No. 5,042,809).

Fuchs disclose a method and apparatus for playing a card game wherein a processor selects data symbols from a large number of predetermined inventory in accordance with a randomizing criteria (Column 1, lines 15-18). Thus the predetermined number of symbols represents a fixed amount and can be arranged into sets of at least two indicia each (FIG 4). These symbols the processor selects are fundamentally stored in a data structure. The player can then place a wager (Column 7, lines 45-51). The player can play a series of hands and for each hand of play; the symbols are selected from the data structure (Column 1, lines 15-18) and are presented on a display (FIG 4). A win is made dependent on the appearance of certain symbols that define a winning and losing hand (Column 8, lines 55-61), which is determined by comparing the outcome to a predetermined schedule of winning outcomes. The symbols are displayed into a game matrix to determine winning and losing combinations based on paylines (FIG 4; Column 8, lines 48-49).

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Though Fuchs disclose only one payline, the use of a plurality of paylines is notoriously well known in the art and would have been obvious to the system of Fuchs in order to provide the player with more winning opportunities per hand.

It is disclosed that the number of symbols are predetermined (Column 9, lines 23-27), and are selected randomly (Column 1, lines 15-18). Further, it is axiomatic to the functionality of the device that the symbols would be stored in a data structure for access. Fuchs discloses that the symbols are displayed in accordance with a pre-established game plan and are stored in a list (Column 4, lines 45-59). Henceforth, it would be obvious to one of ordinary skill in the art that the symbols could be accessed randomly from the list data structure, or alternatively stored in a random order in the list data structure and then accessed serially. Both are well known methods of randomizing data and absent a showing of criticality would have been equivalent design choices to one of ordinary skill in the art.

Fuchs also discloses that at the player's request or because of a repeatedly appearing display of new cards, the player can be presented with a display of the initial game symbols available at the start of the game (Column 9, lines 47-51). Upon a hand being played, the display (FIG 5) will be updated to reflect the new inventory of the symbols (Column 9, lines 54-67). The display of the game symbols of the deck is in the form of a table (FIG 5) including the number left of each type of symbol in the inventory.

The computer will then determine if a player is a winner or loser and issue an award if applicable (Column 10, lines 30-34) based upon a winning schedule (FIG 4, reference 7). The player can then continue play by making another wager. Because it is disclosed that the machine will pay out a win as a function of the wins scored by the player, it is inherent that a second data structure would be storing a reference table to reference a win amount with a player combination.

The remaining indicia display is shown upon completion of the hand as it is stated that from game to game the symbols offered to the player would be deducted (Column 9, lines 61-65). It is also possible to display the constituency of the symbol data after the selection and display of the

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symbol (Column 6, lines 6-36). Thus, as the symbols are deducted, it is logical that winning outcomes become unavailable, as the symbols needed to achieve them are no longer in the indicia set. Thus, for the next hand of play indicia will only be selected from the remaining, yet depleted, inventory.

Fuchs also discloses that it is advantageous to proceed in such a manner that after a certain number of hands and/or after the presentation of a certain symbol, it is possible to reset the entire number of game symbols (Column 3, lines 46-53). This axiomatically rearranges the inventory back into the original state of a list of a predetermined number of signals set in a randomized order (Column 1, lines 15-18; Column 4, lines 45-59). Though Fuchs discloses that a certain number of hands are used as the determining factor, it would be obvious to one of ordinary skill in the art to use a certain number of symbols as the limiting factor. One would be motivated to do this because the symbols represent the actual inventory, thus provide a better indication of when the count of cards may be getting low. Inherently, a counter is used to determine the number of symbols in order to issue a signal to reconstitute at a certain number. Therefore, after a certain predetermined number of symbols have been presented the entire stock of symbols is reconstituted into new symbol data for use in the game.

Fuchs further discloses a payable that is recalculated from game to game as a function of the possible game symbols to display some or all of the winning combinations (Column 10, lines 30-55). The display of Fuchs differs in principle from the fixed lists of all possible winning combinations that are presented on normal gaming machines because the information offered to the player is dependent on the game symbols actually appearing in display symbols or on the symbols which have been held over from a previous game. Therefore, the payable reflects only the possible winning outcomes to aid the player with the relevant information they need in the shortest time possible (Column 10, lines 30-58).

Fuchs discloses reconstituting the inventory when a certain number of symbols have been played or when a certain triggering symbol appears. However, Fuchs does not disclose allowing the player to call for a reconstitution.

Richardson discloses a game where a fixed number of predetermined chances are also used in the form of pull-tabs (Abstract). The number of winning pull-tabs left and the major prizes left are displayed to the player (FIG 3). Richardson provides the player with an input device that can be used to call for a new deal at any time after playing one hand thus issuing a reshuffle signal to prompt the processor to reconstitute inventory (Abstract, Column 3, lines 66-67). Richardson discloses that it is advantageous to allow for a new deal after all the winning chances have been redeemed or if all the major chances have been redeemed. By incorporating this rule and then allowing a player to reconstitute the winning chances, the player will feel in more control of the machine, as they will be allowed to restore all the winning possibilities at any time and thus be more inclined to continue play as no player would continue play on a machine that clearly indicates no winning chances remain. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate this feature in to the device of Fuchs in order to allow the player to call for a reconstitution. One would be motivated to make this combination to allow the player to feel they have a better shot of winning, thus causing the player to play more on the game. Fuchs discloses that when a player feels his game situation is improved and the prospect of winning greater, the actual or apparent improvement in the player's situation greatly enhances the attractiveness of the machine. Thus by allowing the player the power to reconstitute the inventory, this goal would be achieved.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuchs (US Patent No. 5,630,753) in view of Richardson (US Patent No. 5,042,809) in further view of Kinoshita et al. (US patent No. 5,967,894).

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What Fuchs and Richardson disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Regarding the display of a combination of indicia defining at least one scheduled winning outcome, Richardson discloses that the display can be used to show an attainable maximum win (Column 1, lines 25-30) thus it shows a display of a combination of indicia defining at least one scheduled winning outcome. However, Richardson does not substantially disclose the display of sets that have been depleted. While Richardson does achieve this due to the lack of display, Kinoshita et al. discloses an alternate and more informative way of doing so.

Kinoshita et al. disclose displaying information to the player about any winning outcomes that have become eliminated. Kinoshita discloses a paytable wherein outcomes that have been eliminated are displayed with a shading or alternate color (FIG 8(a) or 8(b)). Kinoshita et al. provides motivation for using such a display that it will help a player who is not familiar with the game more easily become associated with it (Column 1, lines 40-48) as well as allows the player to visibly distinguish prize winning hands (Column 3, lines 15-20). One of ordinary skill in the art understands from the disclosure of Fuchs that possible combinations could be eliminated before the actual inventory is refreshed. Otherwise, the inventory could only last one turn and have to be constantly refreshed. Thus, it would have been obvious to one of ordinary skill in the art to incorporate the display method of Kinoshita et al. into the system of Fuchs. One would be motivated to implement the teachings of Kinoshita et al. into the Fuchs system in order to provide the player with a more informative display and help a player who is not familiar with the card game learn the game more easily and become associated with it by seeing not only outcomes that are possible, but those that have been eliminated.

Response to Arguments

Applicant's arguments filed 21 November 2003 have been fully considered but they are not persuasive.

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Regarding Applicants claims that Richardson '809 teaches away from the present invention, the Examiner respectfully disagrees. The type of game Richardson discloses is not relied upon, the teaching of reconstituting a dead inventory is that which the Examiner based the rejection. In response to the fact that the Applicant ascertains that Richardson does not permit reconstitution of the original inventory, the Examiner respectfully submits that when the teaching garnished from Richardson is applied to a card game as disclosed by Fuchs, one of ordinary skill in the art would understand that the original inventory would be replenished, as both slot machines and card games have fixed symbols for use. This point is further addressed in the above rejections.

Regarding Applicants arguments that Richardson is not random in the same way the Applicant's invention is, the Examiner respectfully submits that argument is not coterminous with what is being claimed and does not relate to the teachings garnished from Richardson and applied to Fuchs. The teachings are directed to reconstituting an inventory after certain winning combinations are already played.

Regarding Applicant's arguments that a skilled artisan would have turned away from Richardson since it is directed to a pull-tab game and allowing the player to restock the inventory of tickets would render the game inoperative, the Examiner reminds the Applicant as to the teachings garnished from Richardson. Richardson shows that it is desirable to allow a player to reconstitute an inventory when the winning chances get low, as no player would continue to play without many prizes remaining. This directly applies to Fuchs which depletes inventory as well, no player would continue to play with the majority of the prizes gone, thus one would turn to Richardson as a means to solve such an issue.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The type of game employed by Richardson does not affect the value of the teachings. Further, the Examiner has provided the proper motivation and suggestion in the previous office action. Repeating the previous Office Action: 1) Richardson discloses that it is advantageous to allow for a new deal after all the winning chances have been redeemed or if all the major chances have been redeemed and 2) Fuchs discloses that when a player feels his game situation is improved and the prospect of winning greater, the actually or apparent improvement of the player's situation greatly enhances the attractiveness of the machine. One of ordinary skill in the art would understand that by allowing the player to call for a reconstitution when the player believes all the winning or major chances have been played, the device would achieve the goal desired by Fuchs by allowing the player to further perceive an improvement of their situation. Thus the benefit disclosed by Richardson complements the goal of Fuchs, thus providing one of ordinary skill in the art a suggestion to combine as well as a motivation to do so.

Regarding Applicant's claim that Fuchs does not disclose or suggest displaying information that certain outcomes have been eliminated, the Examiner asserts the argument is rendered moot in view of Kinoshita as disclosed above. Further, even though Fuchs suggests that there should always be an adequate amount of symbols to provide a chance for winning, the Examiner disagrees with the Applicant's interpretation that there must be a chance for winning for every outcome. If that were the case, the machine could be reconstituting after every turn, which is not the purpose or object of Fuchs. Thus, Fuchs does not teach away from such displays as detailed by Kinoshita.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmm
February 9, 2004


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